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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,489	06/23/2003	Ian David Manger	020174-008620US	1122
20350 7590 10/04/2010 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
			EXAMINER HYUN, PAUL SANG HWA	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 10/04/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/602,489

Applicant(s)

MANGER ET AL.

Examiner

PAUL S. HYUN

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 18-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-13, 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 15, 18-31 and 34-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 25, 2010 has been entered.

Claims 1-15 and 18-40 are currently pending wherein claims 1-13, 32 and 33 remain withdrawn pursuant to a restriction requirement. Applicant did not amend any claims.

The amended drawings filed by Applicant has been acknowledged.

Applicant's argument with respect to dependent claim 38 has been fully considered and it is persuasive. The Examiner agrees with Applicant that peristaltic pumping action described by Van Dam et al. does not necessarily suggest that a control channel is independently actuated al other control channels. Thus, a new ground of rejection has been made with respect to claim 38. Despite the new grounds of rejection, no new prior art is cited.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims **14, 15, 18-26, 28-31 and 34-40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Dam et al. (US 2003/0008411 A1) in view of Quake et al. (US 2002/0037499 A1).

Van Dam et al. disclose a microfluidic device and a method for synthesizing a library of compounds by using the microfluidic device (see claim 15), which includes DNA synthesis (see [0056]). The device comprises a solid substrate layer and an elastomeric layer attached to the solid substrate wherein the surface of the solid substrate is immobilized with ligands for binding analytes of interest. The surfaces of both layers can comprise grooves/wells to define a plurality of first flow channels intersecting a plurality of second flow channels (see claim 24 and [0048]). The device further comprises a plurality of control channels associated with each of the flow channels. Each control channel comprises a chamber delimited by an elastic membrane. Upon the application of an actuation force within a control channel, the elastic membrane of the control channel deflects into the flow channel to block fluid flow through the flow channel. The control channels also act as a pump when they are actuated sequentially to facilitate the flow of fluids through the flow channels (see [0068] and [0069]). The device can further comprise additional valves at the waste of the device for redirecting the flow of liquid in a serpentine manner (see [0190]). Based on the disclosure, these additional valves appear to be controlled independently from the valves shown in Figure 12A. The interpretation of the passage is based on the fact that the passage describes an "alternative" embodiment to describe "a plurality of valves at the waste side" as opposed to "the valves at the waste side", and the fact that the

passage indicates that these valves are "designed", rather than "manipulated", to redirect fluid flow.

The method disclosed by the reference comprises the steps of:

- manipulating the control valves to restrict flow in the second flow channels,
- introducing a reagent into the first flow channels such that the reagent binds to the ligands immobilized to the surface of the solid substrate, and
- introducing a sample solution into the second flow channels such that the sample in the sample solution circulates through the flow channels and binds the reagents bound to the immobilized ligands (see claims 25 and 26).

The reference discloses that the term "reagent" refers to oligonucleotides, peptides, monomers, and other small molecules that are building blocks of a larger molecule (see [0056]). While the fluid is being introduced into one of the two flow channels, the other set of flow channels is closed off by means of the control valves in order to prevent cross-contamination (see [0089]). The reference also discloses that reagents/samples that do not bind to the substrate are rinsed off using a solvent (see [0084]). The efficacy of the binding is accomplished by reacting the immobilized ligands with fluorophores and detecting the fluorescence (see [0122]). The method disclosed by Van Dam et al. differs from the claimed method in that Van Dam et al. do not disclose the step of manipulating the valves to form a closed loop.

Quake et al. disclose a microfluidic device similar to the device disclosed by Van Dam et al. Like the device disclosed by Van Dam et al., the device comprises intersecting microfluidic channels and elastomeric valves. Quake et al. also disclose a

method for detecting analytes, the method comprising the steps of hybridizing a sample with probes immobilized to the surface of the microfluidic channels. Quake et al. also disclose the step of manipulating the valves to form a closed loop of flow channels. The closed loop enables the sample to circulate throughout the loop and properly hybridize with the probes (see Abstract and [0076]). Quake et al. also disclose the step of incubating the reaction to enable proper hybridization (see [0310]). In light of the disclosure of Quake et al., it would have been obvious to one of ordinary skill in the art to manipulate the valves of the Van Dam et al. device to form a closed loop of channels during the hybridization step to ensure that the sample and the reagents properly hybridize. It also would have been obvious to incubate the reaction to ensure proper hybridization. Naturally, if one were to form a closed loop of flow channels within the Van Dam et al. device, the closed loop would span multiple rows and columns of channels. Likewise, because the closed loop would span multiple rows and columns, at least two control lines (one for manipulating the x-axis valves and another for manipulating the y-axis valves) would have to be actuated to form the closed loop.

With respect to claims 23-26, Van Dam et al. disclose the step of derivatizing the solid substrate and determining the efficacy of the derivatization (see [0122]). This is accomplished by reacting the immobilized ligands with fluorophores and detecting the fluorescence. In light of the disclosure, it would have been obvious to one of ordinary skill in the art to tag the synthesized compounds produced by the method described above and detect the fluorescence using a fluorescent microscope in order to observe the efficacy of the synthesis.

With respect to claim 31, given that the device disclosed by Van Dam et al. is adapted to perform binding assays, it would have been obvious to one of ordinary skill in the art to react any two entities that bind using the device disclosed by Van Dam et al., including a cell as the reagent and antimicrobes as the sample in order to observe the effects of the antimicrobes on the cell.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Dam et al. in view of Quake et al. as applied to claims 14, 15, 18-26, 28-31 and 34-37, and further in view of Raillard et al. (US 2002/0102577 A1).

Van Dam et al. does not explicitly disclose the usage of a non-optical detector to observe the compound synthesis.

Raillard et al. disclose a method for labeling probes with radio-isotopes that emit radiation (see [0132]). The probe is detected using a detector that is sensitive to radiation.

In light of the disclosure of Raillard et al., it would have been obvious to one of ordinary skill in the art to tag the synthesized compounds produced by the method disclosed by Van Dam et al. with radio-isotope probes instead of fluorophores and detect the radiation using a radiation detector in order to observe the efficacy of the synthesis in the event that fluorophores are not available.

Response to Arguments

Applicant's arguments with respect to claim 38 has been considered but it is moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL S. HYUN whose telephone number is (571)272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul S Hyun/
Examiner, Art Unit 1797

/In Suk Bullock/
Supervisory Patent Examiner, Art Unit 1797